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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/621,400
Filing Date: July 21, 2000
Appellant(s): DERE ET AL.

MAILED

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Technology Center 2100

Michael J. Marcin
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed on August 28, 2006 appealing from the Office action mailed March 28, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences, which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

| | | |
|--------------|--------------|------------|
| 2005/0273436 | Coley et al. | 12/08/2005 |
| 6,006,035 | Nabahi | 12/21/1999 |

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 6-7, 11-13 and 39-41, are rejected under 35 U.S.C. 102(e) as being anticipated by Coley et al. (US Pub. No. 2005/0273436).

As to claim 1, Coley et al. (hereinafter referred as Coley) disclosed a method for managing an automated license installation on a client machine [Fig. 1], which comprising:

- retrieving license information of the client computing system from a license database located on a remote server [e.g., Abstract, lines 1-4];

- receiving a selection of a configuration of the retrieved license information [e.g., P. 4, section: 0031, P. 11, section: 0102; P. 13, section: 0115];

- confirming the configuration of the retrieved license information on the client computing system [e.g., P. 5, sections: 0051-0059]; and

- receiving one of a license file relating to the confirmed configuration of the information and an error message [e.g., P. 5, sections: 0052-0053; P. 6, section: 0059, P. 9, section: 0089].

As to claim 2, Coley further discloses that the step of requiring an entry of a valid PIN number [e.g., the valid license record of a client at P. 3, section: 0024].

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As to claim 3, Coley further discloses requiring an affirmative permission of the client computer system before retrieval of license information from the license database [e.g., P. 6, section: 0059].

As to claim 4, Coley further discloses the step of determining whether a flexible license management utility software is installed on the client computing system, and installing the flexible license management utility software if it is not in the client system [e.g., Abstract, lines 8-13].

As to claim 6, Coley further discloses the step of updating the license database on the configuration of the retrieved license information [e.g., P. 5, section: 0049].

As to claim 7, Coley further discloses the license installation option on the client computing system comprising a floating license installation [e.g., P. 7, section: 0067].

As to claims 11-12, Coley further discloses: querying the client computing system on determining whether the previously installed license file is valid and performing an updating operation to replace the previously installed license file [e.g., Coley: P. 10, section: 0094].

As to claim 13, Coley further discloses determining if a network connection exists to the client computing system [e.g., sections: 0051-0052].

As to claim 39, Coley further discloses sending a message requesting license information [e.g., P. 5, section: 0046].

As to claims 40-41, Coley further discloses that the message includes request code and available licensed products [e.g., P. 5, section: 0052].

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9-10, 17, 22 and 24-25, are rejected under 35 U.S.C. 103(a) as being unpatentable over Coley et al. (US Pub. No. 2005/0273436) and in view of Nabahi (U.S. Patent No. 6,006,035).

As to claims 9-10, Coley does not expressly disclose the step of determining an operating system of the client computer system and set up the configuration variable accordingly.

However, Nabahi discloses the claimed features by using simplified script language file [e.g., col. 5, lines 23 – 60].

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Coley and Nabahi are both in the same endeavor to install software application via dynamic configuring a client computer system, hence it would have been obvious for an ordinary skilled artisan at the time the invention was made to apply the well-known technique as taught by Nabahi into Coley's invention steps to determining an operating system of the client computer system and set up the configuration variable accordingly, because by doing so, the combined method will be upgraded as more flexible for facilitating the dynamic configuration processing.

As to claims 17, 22 and 24-25, the claimed system are deemed to be made obvious for the functions as recited in the claims 1-13 and 39-41 in a combination as discussed above, thus, these claims are rejected for the same reasons.

(10) Response to Argument

Applicant's arguments filed on Aug. 28, 2006 have been fully considered but they are not persuasive.

For claims 1-4, 6, 7, 11-13 and 39-41: the Examiner disagrees with Appellant's piecemeal interpretation and arguments against the 35 U.S.C. § 102(e) rejections on record. The arguments are summarized as following:

1) Coley does not relate in anyway whatsoever to installation of software licenses;

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2) Corley neither discloses nor suggests "receiving a selection of a configuration of the retrieved license information" as recited in claim 1;

3) Corley neither discloses nor suggests "confirming the configuration of the retrieved license information on the client computing system" as recited in claim 1.

In reply to arguments 1, the Examiner directs Appellant's attention to the following excerpts of Corley :

"Whether used in a personal or commercial computing environment, systems incorporating the present invention allow client software to be enabled or re-enabled at any time without significant delay. Software applications operating in accordance with the present invention can be installed on any computer in the world having access to a public network, such as the Internet." (Section: 0031)

Therefore, in contrary to Appellant's arguments, Corley clearly disclosed his invention is for the installation of software licenses.

In reply to the arguments 2), the Examiner counters by pointing out the following excerpts of Corley:

"If so desired, a client application can be configured to not operate unless it receives acknowledgment of the presence of a valid license record. As the use of computers expands globally, a licensing system in accordance with the present invention can ensure that a client application operating on any computer in the world is properly licensed." (Section: 0031)

Here, Corley clearly discloses his licensing installing system is configurable to ensure that a client application operating on any computer in the world is properly licensed and the client will receive acknowledgement of the configured presence of a valid license record.

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Corley further discloses the following:

"Another aspect of systems operating in accordance with the invention is feature enablement. The systems described above can be used to enable and disable particular features in a client application. Such a situation may occur wherein a software application has several levels of operating capability. For instance, a user can selectively enhance operating capability by selecting features defined in a software feature application menu. In response, an associated client module can invoke the Check Out License procedure wherein the desired feature name is passed upstream. The license, of course, does not exist yet, but the system can be configured to direct the user to, or provide the user with, a feature enablement menu that requests that the user enter credit card information, as described above. Alternatively, the system can be organized to automatically initiate a process that creates a license when new software is brought up. This can involve a mechanism that forms a Web server connection and supplies an authorization message that creates a database license entry. For a commercial client, a software provider can monitor the activation and use of client application features and bill the client accordingly." (Section: 0102)

"In an exemplary commercial embodiment, the present invention can take the form of a software package comprised of floppy disks, a CD-ROM, or even a downloadable package. The software package may consist of a library of object modules that can be selected, as needed, by a software applications designer. The designer may select various object modules from the library for insertion into a pre-compiled version of a software application. The entire software application, including the selected object modules, are compiled to create a single executable client application. The selection of insertion points and frequency is left to the discretion of the designer. Validation check watchdog timers can be distributed throughout a software application. Validation checks can be inserted to correspond to various interrupts, or procedure calls within the software application (e.g., printing, saving). An opening routine in the software application can be selected for insertion of an initial license validation or enablement check." (Section: 0115)

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Here, Corley clearly discloses his system is configurable for a user to select operational services via software features menu or to provide a software package that allows a user (e. g., a software application designer) to receive a selection of a configuration of the retrieved license information for insert/install into a pre-compiled version of a software application based on the user's discretion. Thus, in contrary to Appellant's arguments, Corley clearly disclosed the features as claimed.

In reply to the 3) arguments, the Examiner further directs Appellant's attention to one of the embodiment as shown in Fig. 1 of Corley's, for which he cited the following:

"An exemplary process of operating the arrangement depicted in FIG. 1 is shown in the flowchart of FIG. 2. The frequency and timing for performing a license validation check can be selected according to the discretion of the software application designer. In the exemplary process depicted, the client module performs an initial check each time the software application is brought up (step 200). The license validity checking process is initiated (step 202) by utilizing a modem to form an Internet connection between the computer 100 and a licensing server (step 204). This may be done by having the client module instruct the modem to dial a 1-800 number maintained by the software provider that accesses a local Internet gateway (if used in the United States)." (Section: 0051)

"Once the connection is confirmed (step 206), the client module 103 forms a license validity inquiry request message (step 208). The request message may contain information such as the application name, the application version number, a date/time stamp, the name of a license server 110 (if several license servers are maintained by the software provider), and a hardware identifier, such as the IP address of the computer 100. After formation, the request message is sent to the license server 110 (step 210) over a public network*. The agent module 114 in the license server 110 forms a query (step 212) to determine whether a corresponding license record is stored in the database 112

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(step 214). The agent module 114 also can record audit information from the request message (step 213). If the query locates a record of a license for the request, a response message is returned having a license ID field comprising a pointer to the location of the license record in the database 112 (step 218). If the query does not locate a record of a license for the request, a response message is returned having a null indication in the license ID field (step 216). The response message is returned to the client module 108 (step 220) after which the Internet connection is closed (step 222)."
(Section: 0052)

"The client module 108 investigates the response message to determine whether the license ID field contains a license ID (step 224). If the license ID field is null, the client module 108 fails to enable the software application, or disables it (step 226). The client module 108 may then prompt the user with any variety of messages (step 227). For example, the user may be prompted to assess whether a demonstration period of operation would be acceptable. If so, this information can be recorded in the client module 108 and be passed upstream in the context of a next validity inquiry request message. The server 110 will record this information in the database 112. Alternatively, the user can be prompted to contact a sales representative or automated operator to purchase a license, or directed to a Web homepage where a license for the software application can be purchased. In the event of a license purchase, the database 112 can be automatically updated to record the license. Thereafter, a validity check will find a license record and allow the client application 103 to be enabled." (Section: 0053)

"If the license ID field contains a license ID, this information is recorded by the client module 103 for future use (step 228). The client module 108 then enables the software application 102 (step 230). The client module may, at this point, start a timer (step 232) for periodic checking of license validity. Such a validity check is automatically initiated when the timer expires (step 234). The client module also can be configured to initiate a validity check whenever an interrupt is present indicating a certain activity (step 236), such as printing or saving." (Section: 0054)

"Periodic checks performed at timer expiration, or upon appropriate interrupt, use the license ID, which is a pointer,

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to directly access the database record corresponding to the license. If the license record is found, a response message indicates so, the software remains enabled, and the timer is reset. If the record is found empty, it may indicate that the license has expired. The response message will indicate this, and the software can be disabled. Alternatively, the user may be requested to renew the license within a certain period of time before the software application 102 is disabled." (Section: 0055)

"The date/time stamp information passed upstream in the license validity inquiry request message can be used to detect whether the system date/time information on the computer 100 has been tampered with. This is done by comparing the date/time information passed in the request message with the date/time information maintained on the licensing server 110. Furthermore, in preferred embodiments of the invention, license ID information is communicated between the client module 108 and the agent module 114 in an encrypted form, as explained in greater detail below." (Section: 0056)

"In the event that no license is found, several response options are available which vary according to the requirements of, and discretion of a designer of the software application 102. As previously mentioned, a response can be to provide the user with a phone number through which a software license can be purchased, or to direct the computer user to a Web homepage maintained by the software provider. Alternatively, the client module 108 can directly initiate a session with the Web server 118 that supports a homepage through which the user can purchase a license. A first screen on such a homepage can prompt the user to indicate whether the purchase of a full license would be desirable, or whether a demonstration period is preferable to evaluate the application. If neither of these options is selected the session is terminated. If the user opts to take a license, the user can be prompted with questions asking which features in the software application are to be enabled (the price of the license can be adjusted accordingly). The session can conclude with the presentation of a payment screen inviting the user to enter credit card information, or to call a sales representative in order to supply payment information." (Section: 0057)

"If credit card information is supplied in the homepage session, it can be gathered using the system disclosed in the U.S.

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patent application Ser. No. (BDSM Attorney Docket No. 025553-014) entitled: "System for Securely Storing Information Received Over a Public Network," by Coley and Wesinger, filed on Feb. 6, 1996, and incorporated herein by reference in its entirety. Once the credit card information is entered, a response message can be sent to the client module 108 temporarily enabling the software application 102. The database 112 can then automatically updated with a license record. If a credit card turns out to be invalid, the license server database 112 can be updated accordingly by removing the license record and thereby disabling the software pursuant to a next inquiry." (Section: 0058)

"The exemplary inventive system described above allows client applications(i.e., software application having client modules) to be freely distributed while reasonably ensuring that they are, or will be, licensed if used. Any software application having a licensing system client module attached will not operate unless and until the license system client module receives authority to enable the software application. Such a
system allows global proliferation of the software, even in the form of a copy." (Section: 0059)

Here, Coley clearly disclosed an example of confirming (or ensuring) the configuration of the retrieved license information in a client/server license installing system over open Internet database communications as recited in claim 1.

Thus, based on the discussion above the rejections under 35 U.S.C. are maintained.

For claims 9-10, 17, 22 24 and 25, the Examiner disagrees with Appellant's piecemeal interpretation and arguments against the 35 U.S.C. § 103(a) rejections on record. The arguments are summarized as following:

1) Neither Coley nor Nabahi, either alone or in combination, discloses or suggests: "receiving a selection of a configuration of the retrieved license information" and "confirming the configuration of the retrieved license information on the client computing system" as recited in claim 1. Accordingly, Appellellant regards claims 9 and 10 are non-obvious.

2) Neither Coley nor Nabahi, either alone or in combination, discloses or suggests: "a setup program which resides on the client computing system, the setup program configured to send post request containing user information using hypertext transfer protocol (HTTP) over a network to an HTTP port" and "a turning agent which resides on a remote server system assessable via the network and having the HTTP port and a firewall, the turning agent configured to received the post requests from the HTTP port" as claimed in claim 17.

In reply to the arguments of 1), the Examiner counters by points out since Coley clearly disclosed the "receiving a selection of a configuration of the retrieved license information" and "confirming the configuration of the retrieved license information on the client computing system" as discussed above, thereby, the arguments from Appellellant are moot.

In reply to the argument of 2), the Examiner further points out the followings:

a) the claimed "a setup program which resides on the client computing system, the setup program configured to send post request containing user information using hypertext transfer protocol (HTTP) over a network to an HTTP port" read by "the combination of the client module (e.g., the unit 108, Fig. 1) and software (e.g., the unit

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102, Fig. 1)" that is configured to send post request containing user information (e.g., the user's selection of prompted information at Section: 0053) using hypertext transfer protocol (HTTP) over a network (e.g., the Internet unit 116, Fig. 1) to an HTTP port (e.g., a port for an Internet Web server connection at Section: 0102).

b) the claimed "tunneling agent which resides on a remote server system accessible via the network" read by "the Agent Module (e.g., the unit: 114, Fig. 1)" and "the Internet" (e.g., the unit 116, Fig. 1), wherein, the Internet system is deemed to have the claimed HTTP port (e.g., a port for an Internet Web server connection at Section: 0102) and firewall communication (e.g., the authorization messages at Section: 0102) as disclosed by Coley.

For the above reasons, it is believed that the rejections should be sustained.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Respectfully submitted,

Susan Y Chen
Examiner
Art Unit 2161

Susan Chen
11/10/2006

Conferees:

Jeff Gaffin

Supervisory Patent Examiner

Lynne Brown

Supervisory Patent Examiner

Lynne H. Browne
Lynne H. Browne
Appeal Specialist, TQAS
Technology Center 2100